

REMARKS

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 1, 3, 5, 7 to 11, 13 to 17, 19 to 25, 28 to 33 and 35 to 37 are currently pending, claims 14, 22, 28, 29 and 36 have been canceled, and claims 1, 3, 5, 15, 16, 23, 25, 32, 33 and 35 have been amended.

The Office Action mailed November 19, 2003 addressed claims 1, 3, 5, 7 to 11, 13 to 17, 19 to 25, 28 to 33 and 35 to 37. Claims 1, 3, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21, 23 to 25, 29, 32, 33 and 35 to 37 were rejected, claims 10, 14, 22, 28 and 30 were objected to, and claim 31 was allowed.

Claims 5, 7 to 11, 13, 14 and 16 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner further stated that claims 5 and 16 recite a "cover having at least one of (i) ... and (ii)", and the language implies that the golf ball can have both (i) and (ii) at the same time.

Although Applicants respectfully disagree and submit that the claims are enabled, claims 5 and 16 have been amended to recite the cover features in the alternative by replacing "and" with "or". Applicants respectfully submit that this overcomes the rejection and request that the Examiner reconsider and withdraw the rejection of claims 5, 7 to 11, 13, 14 and 16 under 35 U.S.C. § 112, first paragraph.

Claims 5, 7 to 11, 13, 14, 16 and 35 to 37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner stated that claims 5 and 16 recite the cover having at least features (i) and (ii) wherein the specification makes clear that the cover may have either features (i) or (ii). The Examiner further stated that claim 35 recites "said center component ... and said core component..." and asks if "core component" should be "core layer".

As discussed above, claims 5 and 16 have been amended to recite the features in the alternative by replacing "and" with "or". Regarding claim 35, Applicants thank

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the Examiner for pointing out the typographical error. Claim 35 has been amended as suggested by the Examiner. Applicants respectfully submit that this overcomes the rejection and request that the Examiner reconsider and withdraw the rejection of claims 5, 7 to 11, 13, 14, 16 and 35 to 37 under 35 U.S.C. § 112, second paragraph.

Claims 1, 5, 8, 9, 11, 13, 15 to 17, 19 to 21, 33, 35 and 37 were rejected under 35 U.S.C. 102(e) as being anticipated by Higuchi et al. (US 5,725,442).

Although Applicants respectfully disagree with the Examiner, claims 1, 5, 15 and 33 were amended to include the limitation of claims 14 and 22, which were objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claims 14 and 22 have been canceled. Applicants respectfully submit that claims 1, 5, 15 and 33 are therefore allowable. Claim 35 was amended to incorporate the limitation of claim 36, which was not rejected over art, therefore claim 35 is allowable. Claims 8, 9, 11, 13, 16, 17, 19 to 21 and 37 depend from claims 5, 15 and 35 and are therefore also allowable.

Since, as discussed above, Higuchi et al. fails to teach each and every element of Applicants' claims, Applicants respectfully submit that Higuchi et al. does not anticipate Applicants' claims. Applicants respectfully submit that claims 1, 5, 8, 9, 11, 13, 15 to 17, 19 to 21, 33, 35 and 37 are not anticipated by Higuchi et al. and request that the rejection of claims 1, 5, 8, 9, 11, 13, 15 to 17, 19 to 21, 33, 35 and 37 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Claims 3, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21, 33 and 35 were rejected under 35 U.S.C. 102(e) as being anticipated by Egashira et al. (US 5,439,227).

Although Applicants respectfully disagree with the Examiner, claims 3, 5, 15 and 33 were amended to include the limitation of claims 14 and 22, which were objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claims 14 and 22 have been canceled. Applicants respectfully submit that claims 3, 5, 15 and 33 are therefore allowable. Claim 35 was amended to incorporate the limitation of claim 36, which was not rejected over art, therefore claim

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35 is allowable. Claims 7 to 9, 11, 13, 16, 17 and 19 to 21 depend from claims 5 and 15 and are therefore also allowable.

Since, as discussed above, Egashira et al. fails to teach each and every element of Applicants' claims, Applicants respectfully submit that Egashira et al. does not anticipate Applicants' claims. Applicants respectfully submit that claims 3, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21, 33 and 35 are not anticipated by Egashira et al. and request that the rejection of claims 3, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21, 33 and 35 under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

Claims 23, 24 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (US 5,725,442) in view of Sullivan et al. (US 5,803,831).

Although Applicants respectfully disagree with the Examiner, claims 23 and 32 were amended to include the limitation of claim 22, which was objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 22 has been canceled. Applicants respectfully submit that claims 23 and 32 are therefore allowable. Claim 24 depends from claim 23 and is therefore also allowable.

For at least these reasons, Applicants respectfully submit that claims 23, 24 and 32 are not obvious under 35 U.S.C. § 103(a) over Higuchi et al. in view of Sullivan et al. Applicants therefore respectfully request that the rejection of claims 23, 24 and 32 under 35 U.S.C. § 103(a) as obvious over Higuchi et al. in view of Sullivan et al. be reconsidered and withdrawn.

Claims 23, 24 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Egashira et al. (US 5,439,227) in view of Sullivan et al. (US 5,803,831).

Although Applicants respectfully disagree with the Examiner, as discussed above, claims 23 and 32 were amended to include the limitation of claim 22, which was objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 22 has been canceled. Applicants respectfully submit

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that claims 23 and 32 are therefore allowable. Claim 24 depends from claim 23 and is therefore also allowable.

For at least these reasons, Applicants respectfully submit that claims 23, 24 and 32 are not obvious under 35 U.S.C. § 103(a) over Egashira et al. in view of Sullivan et al. Applicants therefore respectfully request that the rejection of claims 23, 24 and 32 under 35 U.S.C. § 103(a) as obvious over Egashira et al. in view of Sullivan et al. be reconsidered and withdrawn.

Claims 25 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (US 5,688,595) in view of Wu (US 5,334,673).

Although Applicants respectfully disagree with the Examiner, claim 25 was amended to include the limitation of claim 28, which was objected to as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and claim 28 has been canceled. Claim 29 has also been canceled by this amendment.

Applicants respectfully submit that claim 25 is therefore allowable.

For at least these reasons, Applicants respectfully submit that claims 25 and 29 are not obvious under 35 U.S.C. § 103(a) over Yamagishi et al. in view of Wu. Applicants therefore respectfully request that the rejection of claims 25 and 29 under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. in view of Wu be reconsidered and withdrawn.

Claims 10, 14, 22, 28 and 30 were objected to by the Examiner as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As previously discussed, the limitation of claims 14, 22 and 28 were included in the independent claims. Claims 10 and 30 depend from the amended claims, and are therefore also allowable. Applicants respectfully request that the Examiner withdraw the objection to claims 10, 14, 22, 28 and 30.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

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**CONCLUSION**

Applicants respectfully request reconsideration and allowance of each of the presently objected and rejected claims, claims 1, 3, 5, 7 to 11, 13 to 17, 19 to 25, 28 to 30, 32, 33 and 35 to 37. Applicants respectfully request allowance of claims 1, 3, 5, 7 to 11, 13, 15 to 17, 19 to 21, 23 to 25, 30 to 33, 35 and 37, the claims currently pending.

Respectfully submitted,

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